

REMARKS

Claims 1-51 remain pending in the application with claims 13-33 and 36-51 being withdrawn from consideration. By the present amendment claim 1 has been amended.

The Examiner rejected claims 1-12, 34, and 35 under 35 U.S.C. § 103(a) as being unpatentable over Alderman U.S. Patent No. 2,526,792 in view of the publication of Nakamura et al. The Examiner admits that Alderman does not disclose use of waxy wheats or coating of the grains with an edible coating. The Examiner relies on Nakamura et al for the disclosure of waxy wheats.

Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention absent some teaching, suggestion, or motivation that would lead one of ordinary skill in the art to combine the references. *In re Sang Su Lee*, 227 F.3d 1338 (Fed. Cir. 2002), citing *Brown & Williamson Tobacco Corp, v. Phillip Morris, Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000); *In re Napier*, 34 U.S.P.Q. 2d 1782 (Fed. Cir. 1995). Elements of separate prior patents cannot be combined when there is no suggestion of such combination anywhere in those patents. *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ 2d 1593 (Fed. Cir. 1987). Virtually all inventions are necessarily combinations of old elements and, thus the notion that combination claims can be declared invalid merely upon the finding of similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under section 103. *Id.* The U.S. Court of Appeals for the Federal Circuit recently made the following statements in *Yamanouchi Pharmaceutical Co., Ltd. v. Danbury Pharmacal, Inc.* 56 USPQ2d 1641, 1644 (Fed. Cir. 2000) concerning the combination of old elements:

"virtually all [inventions] are combinations of old elements. Therefore, an Examiner [or accused infringer] may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate the patentability very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner [or accused infringer] to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention...To counter this potential weakness in the obvious construction, the suggestion to combine requirements stands as a critical safe guard against hindsight analysis and rote application of the legal test for obviousness." [Emphasis added]

Further, when claimed subject matter has been rejected as being obvious in view of a combination of prior art references a proper analysis under section 103 requires a consideration of two factors: [1] Whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and [2] whether the prior art would also have revealed that, in so making or carry out , those of ordinary skill would have a reasonable expectation of success. *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991), *In re Dow Chemical Company*, 5 USPQ2d 1529 (Fed. Cir. 1988). Both the suggestion and the reasonable expectation of success must be found in the prior art not in the applicant's disclosure. *Id.*

When analyzing the issue of obviousness, the differences between the prior art and the claims that issue must be ascertained. *Graham v. John Deer Co.* 148 USPQ 459, 467 (Sup.Ct.1996). In conjunction with the first three "Graham factors" personal of the US Patent

and Trademark Office should: (1) Determine the "scope and content of the prior art"; (2) Ascertain the "differences between the prior art and the claims that issue"; and (3) Determine the "level of ordinary skill in the art". Official Gazette, 1196 OG 38, March 11, 1997. With respect to the scope and content of the prior art each reference must qualify as prior art under 35 U.S.C. § 102, and should be in the field of the applicant's endeavor or be reasonably pertinent to the particular problem with which the inventor was concerned. *Id.* The mere fact that the prior art can be modified does not make the modification obvious unless prior art taught or suggested the desirability of the modification. *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

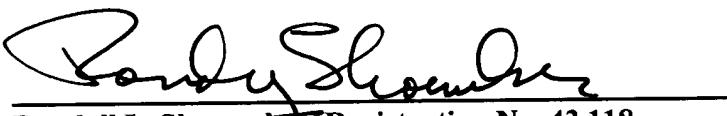
Support for the amendment to claim 1 is found on page 9 of the specification at lines 1-6. As amended claim 1 is directed to a cooked, buoyant waxy wheat comprising no more than about 10% amylose starch and less than 20% by weight protein that is characterized by being gelatinized throughout and is storage stable in the absence of additives that inhibit development of rancidity. As noted by the Examiner Alderman fails to disclose any cooked buoyant waxy wheat compositions whatsoever. The Examiner relies on Nakamura et al for the disclosure of a waxy wheat. Nakamura et al, however, fails to disclose the waxy wheat having the protein content required by present claim 1 and found to be important for carrying out the invention as disclosed on page 9 of the present specification. There is nothing within either of the cited references that would lead one of ordinary skill in the art to specifically select a waxy wheat having a low protein content as required by claim 1 of the present invention. Because neither of the references alone or in combination disclose or make obvious each and every limitation of independent claim 1 the rejection of claim 1, and the claims which depend therefrom, under 35 U.S.C. § 103(a) based on the cited references is improper and should be withdrawn.

Applicant's attorney respectfully submits that the claims as amended are now in condition for allowance and respectfully requests such allowance.

Respectfully submitted,

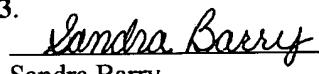
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